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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,719

12/03/2003

Keith A. Thuerk

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EXAMINER

FRITZ, BRADFORD F

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,719	<b>Applicant(s)</b> THUERK, KEITH A.	
	<b>Examiner</b> BRADFORD F. FRITZ	<b>Art Unit</b> 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10, 38-42, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 38-42, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments see the middle of page 9, filed 10/07/2009, with respect to the rejection(s) of claim(s) 1-4, 10, 38-41, and 43-45 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wick (6,691,162), Quillen (7,266,776), Aggarwal (6,260,148), Sylvain (2004/0122901), and Ogle et al. (6,430,604).
2. Applicant's other arguments filed 10/07/2009 have been fully considered but they are not persuasive.

In the remarks, applicant argued in substance that:

(A) Quillen does not disclose that the contacts in the group are inactive subscribers.

As to point (A), the Examiner respectfully disagrees. Quillen clearly discloses contacts in the group (*the group corresponding to the buddylist as a whole or the offline group*) are inactive subscribers, because Quillen discloses subscribers which may be idle or offline, either of which corresponds to being inactive (see column 3, lines 10-13 and Fig. 6, the offline group within item 210).

(B) Prior art does not teach selecting inactive subscribers to form a group of inactive subscribers.

As to point (B), the Examiner respectfully disagrees. Quillen teaches that the user can select any of the screen name(s) (i.e., randomcontact, randomcontact2) or groups (i.e., Buddies, AOL, Family, Co-workers, Offline) of screen names in the buddy list and set up alerts (see column 3, lines 10-13, and Figs. 6-8). Alternatively the same actions can be performed on the items in the buddy list view in which an icon shown as a screenname label representing a subscriber or list of subscribers (Fig. 6) as well as on the icon view, where the icon is an actual graphic (Fig. 8) (column 1, lines 40-45). Quillen states that alerts can be set for any of the users in the buddy list, by "double clicking" or "right clicking" on the buddy icon (column 5, lines 5-15).

Again, the Examiner notes that Quillen clearly states that the actions performed on the icons in the window view in fig. 8 are the same actions which can be performed in the buddylist view Fig. 6-7 (column 1, lines 5-15).

(C) Prior art does not teach that the inactive subscribers selected from the list of subscribers are displayed in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change.

As to point (C), the Examiner respectfully disagrees. Quillen clearly teaches that the inactive subscribers selected from the list of subscribers are displayed in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change, because those buddies are clearly shown in the buddy list in figures 5-7. The

Examiner notes that if the Applicants intend that their buddies in a buddy list (subscribers) are displayed in such a specific manner that is more visually distinctive than the manner in figures 5-7 of Quillen, then the Applicants are free to amend accordingly.

(D) Regarding claims 3 and 40, the actions of sounding an alarm (step 54); sending an IM (step 55), opening a conversation window on the pouncer's client system (step 56); or executing a user-specified command (step 57) as shown in Fig. 5 of Wick are different from a notification action, a prompting action, and a message conveyance action, as recited in Claims 3 and 40.

As to point (D), the Examiner respectfully disagrees. Sounding an alarm corresponds to the claimed "notification action", executing a user-specified command (step 57) corresponds to the claimed "a prompting action", and Wick's opening a conversation window corresponds to the claimed "message conveyance action".

### ***Claim Objections***

3. Claims 1, 38, and 45, are objected to because of the following: the claim term "can" is recited in the limitation "...so that a user can identify the subscribers...". The claim term "can" causes the limitation to be indefinite. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 10, 38-41, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable by Wick (6,691,162) in view of Quillen (7,266,776), hereinafter referred to as Quillen, in view of Aggarwal (6,260,148), further in view of Sylvain (2004/0122901).

6. Regarding claims 1, 38, and 45, Wick disclosed displaying a user selectable list of subscribers of an instant messaging service; selecting a subscriber in an inactive state from the list (column 5, lines 6-55 and Fig. 5), designating at least one action associated with the [subscriber], the at least one designated action to be automatically performed with respect to each subscriber in the group (column 5, lines 6-55 and Fig. 5 and 4); automatically detecting a state change of at least one of said subscribers in said group (column 5, lines 6-55 and Fig. 5).

However, Wick does not explicitly teach selecting a group of subscribers within a list, displaying in the graphical user interface the subscribers in the selected group in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change, designating at least one action with the group, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change, automatically executing said designated action

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associated with said group for said at least one subscriber responsive to said detecting step.

Quillen teaches selecting a group of subscribers within a list (column 10, lines 35-40 and column 12, lines 36-50), displaying in the graphical user interface the subscribers in the selected group in a visually distinctive manner so that a user can identify the subscribers being monitored for a state change (column 10, lines 35-40 and column 12, lines 36-50, Figs. 5-7), designating at least one action with the group (column 10, lines 35-40 and column 12, lines 36-50), the at least one designated action to be automatically performed with respect to each subscriber in the group (column 10, lines 35-40 and column 12, lines 36-50), automatically executing said designated action associated with for said at least one subscriber responsive to said detecting step (column 10, lines 35-40 and column 12, lines 36-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Quillen in the system of Wick because both are from the same field of endeavor and in order to “facilitate communications between computer users across a network” (*see title*).

However, the above combination does not explicitly teach the inactive state being any state where an instant messaging session cannot be established with a subscriber, types of inactive state including an offline state, a do-not-disturb state (busy), displaying in the graphical user interface options of action to be performed when a subscriber in the selected group becomes active. Aggarwal teaches the inactive state being any state where an instant messaging session cannot be established with a subscriber

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(column 13, line 20 – column 15, line 55), types of inactive state including an offline state, a do-not-disturb state (busy), (column 14, lines 10-30, 54-59 and column 15, lines 49-60); displaying in the graphical user interface options of action to be performed when a subscriber in the selected group becomes active (column 13, line 20 – column 15, line 55). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Aggarwal in the combination above because all are from the same field of endeavor and in order to subscribe to a buddy's status and be alerted whenever the status changes.

However, the above combination does not explicitly teach an inactive state including an out-of-office state. Sylvain teaches an inactive state including an out-of-office state (paragraphs 0030, 0072, and Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Sylvain in the combination above in order to subscribe to a status change when the status changes to “out-of-office” because “out-of-office” is an obvious type of inactive state because “[t]he number of properties and devices to which client A can subscribe is enormous. All that is necessary is that client A be able to send a subscribe message to the device, that the device measures or otherwise has notice of the value of the property desired, that client A properly addresses the object having the desired property, and that the device can send messages about the property to client A” (Aggarwal, column 15, lines 50-60).



7. Regarding claims 2 and 39, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between the user and said at least one subscriber (column 5, lines 6-55 and Fig. 5).

8. Regarding claims 3 and 40, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).

9. Regarding claims 4 and 41, Wick disclosed wherein all steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).

10. Regarding claims 10 and 44, Wick disclosed presenting within a graphical user interface a list of said subscribers (column 5, lines 6-55 and Fig. 5), and within said graphical user interface (Fig. 4-5), visually distinguishing said at least one subscriber with state change from other subscribers in said list (column 5, lines 6-55 and Fig. 5).

11. Claims 5 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (6,691,162) in view of Quillen (7,266,776), hereinafter referred to as Quillen, in view of Aggarwal (6,260,148), in view of Sylvain (2004/0122901), further in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

12. Regarding claims 5 and 42, Wick and Quillen disclosed the invention as described above. However, neither explicitly teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to

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include the Lotus Sametime IM client in the system of Wick and Quillen because all are from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another IM client.

### ***Conclusion***

The prior art made of record and not relied upon by the Examiner is considered pertinent to Applicants' disclosure.

**a. Roskind (2003/0065721) teaches personalizing a buddy list in a number of different ways.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. F. F./  
Examiner, Art Unit 2442

/Joon H. Hwang/  
Supervisory Patent Examiner, Art Unit 2447